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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Randy J. Pritzker Wolf, Greenfield & Sacks 600 Atlantic Avenue Boston, MA 02210			EXAMINER CHANDLER, SARA M	
			ART UNIT 3693	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/035,966

Applicant(s)

BURAKOFF ET AL.

Examiner

SARA CHANDLER

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/28/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114-125 and 196-219 is/are pending in the application.
- 4a) Of the above claim(s) 213-219 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 114-125 and 196-212 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 10/035,966 (11/09/01) filed on 02/28/08.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for _____"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "for _____"), but does not result in a

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structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Election/Restrictions

Newly submitted claims 213-219 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

- I. Original claims 114-125 and newly submitted claim 196-212.
- II. Newly submitted claim 213.
- III. Newly submitted claims 214-219.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as before providing access to information, requesting consent of a user to electronic delivery of the information. In the instant case, subcombination II has separate utility such as enabling the user to negatively consent to the electronic access to the information. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as before providing access to information, requesting consent of a user to electronic delivery of the information. See MPEP § 806.05(d). In the instant case,

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subcombination III has separate utility such as enabling a user to request an alternative version of the information. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 213-219 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 114-125 and 196-212 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Claimed invention fails to produce a useful, concrete and tangible result.

Claims 114 and 212 do not provide a “tangible” result. The term “enabling” is abstract because it broadly refers to the concepts of providing the means, opportunity or knowledge to do something. The term “enabling” does not actually require that something is done. In other words, having the means, opportunity or knowledge regarding how to do something does not mean that it will actually be done. Thus, the claim is not tangible because it is both abstract and fails to provide real world value. See also MPEP § 2107.01.

Mental Process: The methods claimed in claims 114 and 212 are not tied to any machine such as a computer system. Furthermore, the broadest reasonable

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interpretation of the claimed invention encompasses the mental processes of a human operator.

It is thus clear that the present statute does not allow patents to be issued on particular business systems - such as a particular type of arbitration - that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable. In re *Comiskey*, 84 USPQ3d 1670.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Objections

Claim 211 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 211 depends from claim 114 which requires that consent is given (i.e., "once the consent is deemed given..."). Claim 211 conflicts with claim 114 because it requires that consent is not given (i.e., "if consent is deemed to not be given by the user...").

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Re Claims 114 and 115: Claim 115 is indefinite because its meaning is unclear in light of claim 114. That is once the consent is given by the user wouldn't it have to concurrently be received? Wouldn't the consent need to be given by the user and received prior to delivery of the information to the user?

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 114-122, 197, 198, 201, 211, 212 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smith, US Pat. No. 6,192,407.

Re Claim: 114,201, 211: Smith discloses a method comprising:

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before providing access to information, requesting consent of a user to electronic delivery of the information (Smith, col. 1, lines 40-63; col. 6, line 12-19; col. 7, lines 12-26; col. 11, lines 15-25; col. 13, lines 18+ - col. 14, line 21; col. 15, lines 4-15; col. 15, lines 28-42); and

once the consent is deemed given by the user, enabling the delivery of the information to the user (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 115: Smith discloses the claimed method supra and further discloses receiving the consent (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42).

Re Claim 116: Smith discloses the claimed method supra and further discloses wherein the consent is received over a computer communications link (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42 In a network environment for the delivery of information, a communication link is inherent).

Re Claim 117: Smith discloses the claimed method supra and further discloses storing an indication of consent (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42).

Re Claim 118: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises sending the information (Smith,

abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 119: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises sending the information to the user in an electronic form (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 120: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises providing instructions for obtaining the information electronically (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 121: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises providing an address on the Internet where the information is located (Smith, abstract, Fig. 18, col. 2, lines 21-36; col. 14, lines 36-54; col. 15, lines 7+-col. 16, line 44).

Re Claim 122: Smith discloses the claimed method supra and further discloses wherein the consent is deemed given by an affirmative action from the user (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42).

Re Claim 197: Smith discloses the claimed method supra and further discloses wherein the address on the Internet is an address on the World Wide Web (Smith, abstract, Fig. 18, col. 2, lines 21-36; col. 14, lines 36-54; col. 15, lines 7+-col. 16, line 44).

Re Claim 198: Smith discloses the claimed method and further discloses, wherein the information comprises a plurality of items of information (Smith, abstract, col. 2, lines 21-36; col. 3, lines 24-36; col. 3, line 58+-col. 4, line 7; col. 11, lines 25-40: col. 12, line 12+ - col. 13, line 32; col. 15, lines 43-53; col. 16, lines 11-20).

Re Claim 212: Smith discloses a method comprising:
before providing access to information, requesting consent of a user to electronic delivery of the information (Smith, col. 1, lines 40-63; col. 6, line 12-19; col. 7, lines 12-26; col. 11, lines 15-25; col. 15, lines 4-15; col. 15, lines 28-42); and
if consent is deemed given by the user, enabling the delivery of the information to the user (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53. See discussion supra regarding “if” as used in the claim. The limitation is interpreted as not required (i.e., because consent may never be given).

Alternatively, Re Claims 114-122, 197, 198, 201, 211, 212: In addition to the explicit teaching-suggestion-motivation (TSM) of Smith supra, the claimed invention would have obvious to one of ordinary skill in the art.

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements deprive prior inventions of their value or utility. *KSR v. Teleflex*,

127 S.Ct. 1727, 82 USPQ2d at 1396 (2007).

Official Notice is taken that it is old and well-known for businesses and organizations to require that before providing access to information, requesting consent of a user to the electronic delivery of the information; and once the consent is deemed given by the user, enabling the delivery of the information to the user. Security, privacy protecting the integrity of information and efficiency are among the rationales. For example, authorizing or authenticating users/clients prior to submitting vulnerable information (e.g., personal, security, financial) information may be needed. For example, targeting communications to those users/clients who are interested and/or proactive (i.e., by indicating their consent to correspondence).

Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Claims 123, 124/114-123, 125/124/114-123, 196/124/114-123, 199, 200 and 202- 210 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US Pat. No. 6,192,407.

Re Claim 123: Smith discloses the claimed method supra and further discloses providing user's with access to software to aid in using the delivery services (Smith, Fig. 16, col. 10, lines 36-51; col. 13, lines 58+-col. 14, line 21). Smith fails to explicitly disclose wherein the consent is requested by sending the user a computer-readable

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device. Official Notice is taken that it was old and well-known at the time the invention was made to place software on computer readable media. For example software is downloaded on various forms of computer readable media for sharing, transport, compatability etc. Thus, to provide wherein the consent is requested by sending the user a computer-readable device was well-known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith to provide wherein the consent is requested by sending the user a computer-readable device. One would have been motivated by profits to increase the number of users who are interested in and have access to the delivery services.

Re Claim 124/114-123, 125/124/114-123 and 196/124/114-123: Smith discloses the claimed method supra but fails to explicitly disclose wherein the information is securities information; wherein the information is compliance information; and wherein the securities information relates to one or more mutual funds.

Regarding, wherein the information is securities information; wherein the information is compliance information; and wherein the securities information relates to one or more mutual funds.

Nonfunctional Descriptive Material

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106, II.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith to provide wherein the information is securities information; wherein the information is compliance information; and wherein the securities information relates to one or more mutual funds.

Claims 124/114-123, 125/124/114-123 and 196/124/114-123 apply a known technique to a known device ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 199, 200 and 207: Smith discloses the claimed method *supra* but fails to explicitly disclose,

wherein consent is deemed given by the user upon the user expressly consenting to electronic delivery;

wherein consent is deemed given by the user when a predetermined period passes after requesting the user's consent without the user having expressly consented to electronic delivery; and

wherein consent is deemed given by the user if consent is deemed given by an entity acting on behalf of the user.

Official Notice is taken that is old and well-known for consent to be given in different ways. Consent may be in the form of affirmative acts such as actively requesting items, paying for items. For example, when a customer asks for an purchase item and hands the cashier the payment. Consent may be in the form of acquiescence. For example, failure to terminate a promotion (e.g., magazine,

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newspaper delivery). Consent may be in given by given by third party authorized to act on behalf of the user. For example, a manager, offer or other designated employee may be authorized to give the consent of a company purchases, agreements etc. For example, an Attorney may be authorized to give consent on behalf of a client.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith to provide wherein consent is deemed given by the user upon the user expressly consenting to electronic delivery; wherein consent is deemed given by the user when a predetermined period passes after requesting the user's consent without the user having expressly consented to electronic delivery; and wherein consent is deemed given by the user if consent is deemed given by an entity acting on behalf of the user.

Claims 199, 200 and 207 apply a known technique to a known device ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 202 and 203: Smith discloses the claimed invention *supra* but fails to explicitly disclose,

wherein the first type of information relates to a first type of document; and

wherein the first type of information relates to a first type of transaction.

Regarding, wherein the first type of information relates to a first type of document; and wherein the first type of information relates to a first type of transaction.

Nonfunctional Descriptive Material

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Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106, II.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith to provide wherein the first type of information relates to a first type of document; and wherein the first type of information relates to a first type of transaction.

Claims 202,203 apply a known technique to a known device ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 204,205,206: Smith discloses the claimed invention supra but fails to explicitly disclose, wherein requesting consent comprises requesting the user's consent to a single electronic delivery of information; and

wherein requesting consent comprises requesting the user's consent to one or more electronic deliveries of information to occur in the future.

Regarding, wherein requesting consent comprises requesting the user's consent to a single electronic delivery of information; and

wherein requesting consent comprises requesting the user's consent to one or more electronic deliveries of information to occur in the future.

Mere duplication of parts has no patentable significance unless new and unexpected result is produced. *In re Harza*, 124 USPQ 378 (CCPA 1960)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings Smith to provide wherein requesting consent comprises requesting the user's consent to a single electronic delivery of information; and wherein requesting consent comprises requesting the user's consent to one or more electronic deliveries of information to occur in the future.

Claims 204,205,206 apply a known technique to a known device ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 208, 209 and 210: Smith discloses the claimed invention *supra* but fails to explicitly disclose wherein the information comprises a first item and one or more other items, and wherein enabling the delivery of the information to the user comprises enabling the delivery of the first item to the user and making the one or more other items of information available to the user when the delivery of the first item is enabled; wherein making the one or more other items of information available to the user comprises making the one or more other items available to the user in hard copy form; and wherein making the one or more other items of information available to the user comprises making the one or more other items available to the user in electronic form.

It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. *In re Venner*, 120 USPQ 192 (CCPA 1958) *In re Rundell*, 9 USPQ 220

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith to provide wherein the information comprises a first item and one or more other items, and wherein enabling the delivery of

the information to the user comprises enabling the delivery of the first item to the user and making the one or more other items of information available to the user when the delivery of the first item is enabled; wherein making the one or more other items of information available to the user comprises making the one or more other items available to the user in hard copy form; and wherein making the one or more other items of information available to the user comprises making the one or more other items available to the user in electronic form.

Claims 208,209,210 apply a known technique to a known device ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

NOTE: The following terms have been given their broadest reasonable interpretation: securities information, compliance information etc.= information.

In regards to "securities information: What type of information regarding the securities is obtained and how it impacts the claimed invention has not been provided. Furthermore, there are no active steps performed with respect to the securities information as compared to any information and no unique features or characteristics have been identified as to the securities information as compared to any information.

"Compliance" by definition refers to acquiescence to or actions taken in accordance with rule(s) and/or standard(s). In the claimed invention what these rules or standards are have not been provided. Furthermore, there are no active steps performed with respect to the compliance information as compared to any information

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and no unique features or characteristics have been identified as to any compliance information as compared to the information.

The label of “securities information” and “compliance information” is nonfunctional descriptive material.

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106, II.

Response to Arguments

Double Patenting

Withdrawn

Claim objections

Withdrawn

101

Applicant's arguments have been fully considered but they are not persuasive.

Claims 114 and 212 do not provide a “tangible” result. The term “enabling” is abstract because it broadly refers to the concepts of providing the means, opportunity or knowledge to do something. The term “enabling” does not actually require that something is done. In other words, having the means, opportunity or knowledge regarding how to do something does not mean that it will actually be done. Thus, the claim is not tangible because it is both abstract and fails to provide real world value. See also MPEP § 2107.01.

Mental Process: The methods claimed in claims 114 and 212 are not tied to any

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machine such as a computer system. Furthermore, the broadest reasonable interpretation of the claimed invention encompasses the mental processes of a human operator.

It is thus clear that the present statute does not allow patents to be issued on particular business systems - such as a particular type of arbitration - that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable. In re *Comiskey*, 84 USPQ3d 1670.

102/103

Prior to receiving documents from the sender, Smith discloses several actions taken by the recipient that demonstrate the recipient's consent or acquiescence to the delivery of information. (E.g., Customizing delivery, security and receipt requirements (Smith, col. 13, lines 19-32); and downloading and installing necessary software (Smith, col. 13, lines 58+ - col. 14, line 4)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

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